

PATENT COOPERATION TREATY

PCT

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INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Rec'd PCT/PTO 26 SEP 2005

10/550661

Applicant's or agent's file reference 101025-1 WO		FOR FURTHER ACTION See Form PCT/IPEA/416	
International application No. PCT/SE2004/000504	International filing date (day/month/year) 01.04.2004	Priority date (day/month/year) 03.04.2003	
International Patent Classification (IPC) or national classification and IPC C07D 211/70, 401/12, 417/12, A61K 31/4465, 31/4523, A61P 25/04			
Applicant AstraZeneca AB et al			

- This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.
- This REPORT consists of a total of 7 sheets, including this cover sheet.
- This report is also accompanied by ANNEXES, comprising:
 - ☐ (sent to the applicant and to the International Bureau) a total of _____ sheets, as follows:
 - ☐ sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).
 - ☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.
 - ☐ (sent to the International Bureau only) a total of _____ (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in electronic form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

- This report contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input type="checkbox"/> | Box No. II | Priority |
| <input checked="" type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input checked="" type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input checked="" type="checkbox"/> | Box No. VIII | Certain observations on the international application |

Date of submission of the demand 18.10.2004	Date of completion of this report 18.07.2005
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INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/SE2004/000504

Box No. I Basis of the report

1. With regard to the language, this report is based on:

- ☐ the international application in the language in which it was filed
- ☐ a translation of the international application into _____, which is the language of a translation furnished for the purposes of:
- ☐ international search (Rules 12.3(a) and 23.1(b))
- ☐ publication of the international application (Rule 12.4(a))
- ☐ international preliminary examination (Rules 55.2(a) and/or 55.3(a))

2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):*

- ☒ the international application as originally filed/furnished
- ☐ the description:
- pages _____ as originally filed/furnished
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☐ the claims:
- pages _____ as originally filed/furnished
- pages* _____ as amended (together with any statement) under Article 19
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☐ the drawings:
- pages _____ as originally filed/furnished
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.

3. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to the sequence listing (*specify*): _____

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to the sequence listing (*specify*): _____

* If item 4 applies, some or all of those sheets may be marked "superseded."

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Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application

☒ claims Nos. 9-10

because:

☒ the said international application, or the said claims Nos. 9-10
relate to the following subject matter which does not require an international preliminary examination (*specify*):

See PCT Rule 67.1.(iv) : Methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods.

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. _____
are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos. _____ are so inadequately supported
by the description that no meaningful opinion could be formed (*specify*):

☐ no international search report has been established for said claims Nos. _____

☐ a meaningful opinion could not be formed without the sequence listing; the applicant did not, within the prescribed time limit:

☐ furnish a sequence listing on paper complying with the standard provided for in Annex C of the Administrative Instructions, and such listing was not available to the International Preliminary Examining Authority in a form and manner acceptable to it.

☐ furnish a sequence listing in electronic form complying with the standard provided for in Annex C of the Administrative Instructions, and such listing was not available to the International Preliminary Examining Authority in a form and manner acceptable to it.

☐ pay the required late furnishing fee for the furnishing of a sequence listing in response to an invitation under Rules 13ter.1(a) or (b) and 13ter.2.

☐ a meaningful opinion could not be formed without the tables related to the sequence listings; the applicant did not, within the prescribed time limit, furnish such tables in electronic form complying with the technical requirements provided for in Annex C-bis of the Administrative Instructions, and such tables were not available to the International Preliminary Examining Authority in a form and manner acceptable to it.

☐ the tables related to the nucleotide and/or amino acid sequence listing, if in electronic form only, do not comply with the technical requirements provided for in the Annex C-bis of the Administrative Instructions.

☐ See Supplemental Box for further details.

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Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	<u>1-8, 11-18</u>	YES
	Claims	_____	NO
Inventive step (IS)	Claims	_____	YES
	Claims	<u>1-8, 11-18</u>	NO
Industrial applicability (IA)	Claims	<u>1-8, 11-18</u>	YES
	Claims	_____	NO

2. Citations and explanations (Rule 70.7)

Cited documents:

D1) US 6187792 B1
D2) WO 02094782 A1
D3) WO 02094783 A1
D4) WO 02094784 A1
D5) WO 02094785 A1

The claims disclose compounds that are used for treatment of pain, anxiety or functional gastrointestinal disorders.

Documents D1-D5 disclose structurally very similar compounds with the same activity as the claimed compounds.

Document D1 which is considered to represent the most relevant state of the art, discloses structurally closely related compounds. The subject-matter of claim 1 differs from D1 (see compound in example 36) in that the substituent in meta-position on the phenyl-group is an aminocarbonyl instead of a methylcarbonyl.

The subject-matter of claim 1 is therefore novel (Article 33(2) PCT).

The problem to be solved by the present invention in the light of document A is the provision of alternative diphenylmethyldene piperidine derivatives useful for treatment of pain, anxiety or functional gastrointestinal disorders.

Documents D2-D5 show structurally related compounds, that are

.../...

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.
Continuation of: Box V

substituted in meta-position on the phenyl-group with an aminocarbonyl, but with the difference that the central carbon atom has been exchanged to a nitrogen atom.

The applicant has not shown that the structural differences render the claimed compounds' unexpected effects in comparison with the known compounds'.

It is considered obvious to a person skilled in the art to modify structurally similar compounds to obtain the claimed compounds and come to the conclusion that they will have the same activity.

Thus, claims 1-8 and 11-18 are considered to fulfil the requirements of novelty, but not that of inventive step.

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Box No. VI Certain documents cited

1. Certain published documents (Rule 70.10)

Application No. Patent No.	Publication date (day/month/year)	Filing date (day/month/year)	Priority date (valid claim) (day/month/year)
WO 03029215	10.04.2003	02.10.2002	03.10.2001

2. Non-written disclosures (Rule 70.9)

Kind of non-written disclosure	Date of non-written disclosure (day/month/year)	Date of written disclosure referring to non-written disclosure (day/month/year)
_____	_____	_____

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Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

Compound 5 in the independent claim 18 is not a compound that can be included in either of formula (I) of claim 1 or formula (IA) of claim 13 and can therefore not be allowed.